

Application No. 10/622,366

PATENT
Docket No.: 10393-41858Remarks

Claims 1-29 are pending in this application, prior to entry of the present amendment. Claims 1-28 were allowed. The rejection of claim 29 was maintained.

Claim 29 has been further amended. New dependent claims 30-46 are presented for entry.

Reconsideration of the rejection of claim 29, as amended, is respectfully requested, as is consideration and allowance of new dependent claims 30-46. The addition of these new dependent claims does not raise any issues not already considered by the examiner, and introduces no new matter.

The allowance of claims 1-28 is noted with appreciation.

Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Wilson* patent in view of the *Kaufman* patent. The examiner asserted that *Wilson* discloses the apparatus to effect the method of having a prize delivery mechanism comprised of a bottle 10 with the prize articles therein, and noted the use of currency slot 34. The examiner took the position that, to provide that *Wilson*'s prize delivery mechanism would be placed into a vending machine would be obvious not only as a mere choice of utility to so place the delivery mechanism into conventional vending machine, but [also] *Kaufman* discloses the use of placing a prize delivery mechanism into a vending machine so as to provide ready dispensing of the prize delivery mechanism.

Claim 29 has been amended to emphasize the novel aspects of the inventive method. In particular, claim 29 now recites a method for delivering a vendable prize delivery article including a premium from a vending machine that requires a local currency. The claim has been amended by including the following two method steps:

- (a) inserting the premium into the vendable prize delivery article at a first location removed from the location of the vending machine, the vendable prize delivery article including a currency slot for receiving local currency for use in a vending machine, and
- (b) inserting local currency into the vendable prize delivery article at a second location where a local currency is applicable for a vending machine.

Application No. 10/622,366

PATENT
Docket No.: 10393-41858

Further, claim 29 now recites the step of placing the vendable prize delivery article including the premium and inserted local currency into the vending machine.

These amendments clearly differentiate the claimed invention from *Wilson* taken alone or in combination with *Kaufman*. As fully explained in the previous Response to First Office Action (filed August 29, 2005, see bottom of page 9), the promotional item of *Kaufman* substantially fills the bottle thereby leaving no room for later insertion of any currency into a currency slot, and *Kaufman* has pre-selected money in the article, thereby obviating later insertion of currency. Claim 29 clearly recites that the premium is inserted into the article at a first location, and that the local currency is inserted at a second location. Furthermore, also described in the previous Response to First Office Action (page 12), and consistent with allowed claim 14, claim 29 relates to a method in which the vendable prize delivery article is inserted with premium in one locale while the insertion of currency into the coin slot is performed at another locale. The labor saving benefits of such a method are clearly spelled out in the specification – see page 14, line lines 18–22, for example.

Finally, *Wilson* does not supply any teachings sufficient to render the claimed method obvious. Again, as previously described in the Response to First Office Action (page 13) the slot described and disclosed in *Wilson* is covered before shipment of the bottle – after all, it is a coin bank with preinserted snack food and not a vendable prize delivery mechanism. It would not be obvious to combine *Wilson* and *Kaufman* and arrive at anything remotely resembling the claimed method, as nothing teaches or suggests the desirability of adding coinage for the vending machine in a second location, after the premium has been inserted.

For the foregoing reasons, it is submitted that claim 29, as amended, is novel, nonobvious, and should be allowable.

New dependent claims 30–46 are presented for entry. Of these claims, 30–43 are almost identical to allowed claim 14's dependent claims 15–28, and are added to provide similar dependent claim coverage for claim 29. New dependent claims 44 and 45 are dependent under claim 29 and are added to include the step of shipping the articles to a

Application No. 10/622,366

PATENT
Docket No.: 10393-41858

second location where the promotion is done (support in FIG. 9, step 4), and that the shipping can be to multiple locations (support on page 14, line 10). New dependent claim 46 is added to recite that the step of shipping to multiple locations comprises shipping to a local country where the promotion is done (again, FIG. 9, step 4).

Conclusion

For the foregoing reasons, it is respectfully submitted that independent claim 29, and the new dependent claims, should all be allowable. The foregoing is presented as a full and complete response to the Office Action mailed November 2, 2005, and is believed to have placed all claims in condition for allowance. Such action is courteously solicited. If any issues remain that can be resolved by telephone, the Examiner is respectfully requested to contact the undersigned at 404-233-7000.

Respectfully submitted,

MORRIS, MANNING & MARTIN, LLP

February 2, 2006

Morris, Manning & Martin, L.L.P.
1600 Atlanta Financial Center
3343 Peachtree Road, N.E.
Atlanta, Georgia 30326
404 504 7720 Direct
404 233 7000 Main


John R. Harris
Reg. No. 30,388
Attorneys for Applicant